

ESTTA Tracking number: **ESTTA648050**

Filing date: **01/02/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92056509
Party	Defendant 3D Systems, Inc.
Correspondence Address	JASON M SNEED SNEED PLLC 610 JETTON ST STE 120-107 DAVIDSON, NC 28036 9318 UNITED STATES jsneed@sneedlegal.com, clandrum@sneedlegal.com, sarah@sneedlegal.com, litigation@sneedlegal.com
Submission	Opposition/Response to Motion
Filer's Name	Gina R. Iacona
Filer's e-mail	giacona@sneedlegal.com, jsneed@sneedlegal.com, sarah@sneedlegal.com, clandrum@sneedlegal.com, litigation@sneedlegal.com
Signature	/Gina R. Iacona/
Date	01/02/2015
Attachments	2015-1-2 3D Systems Response to Further Motion to Compel.pdf(330922 bytes ) 2015-01-02 3D Systems Response to Further Motion to Compel Exhibits 1-3.pdf(1051981 bytes ) 2015-01-02 3D Systems Response to Further Motion to Compel Exhibits 4-6.pdf(691844 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Registrant: 3D Systems, Inc.  
Mark: 3DS & Design  
Reg. No.: 4,125,612 in Classes 1, 7, 9 and 40  
Registered: April 10, 2012

	)	
Autodesk, Inc.	)	
	)	
Petitioner,	)	
	)	
v.	)	Cancellation No. 92056509
	)	
3D Systems, Inc.,	)	
	)	
Respondent	)	

**RESPONDENT’S OPPOSITION TO PETITIONER’S FURTHER MOTION TO  
COMPEL DISCOVERY**

Respondent 3D Systems, Inc. (“Respondent” or “3D Systems”), by and through its undersigned counsel, responds to and opposes Petitioner Autodesk, Inc.’s (“Petitioner” or “Autodesk”) Further Motion to Compel Discovery, filed December 12, 2014, as follows:

**I. Introduction**

Petitioner’s Further Motion to Compel Discovery is premature and unnecessary. Petitioner’s motion is centered on Respondent’s alleged non-production of categories of information, yet Respondent has filed a motion for reconsideration of the Board’s order compelling it to produce such information – as it is entitled to do under the rules. Petitioner’s other complaints concern deficiencies in Respondent’s document production, which it had not even discussed with Respondent before filing its motion, and Respondent’s refusal to produce witnesses for deposition, despite the pending motion for reconsideration, which will determine

which topics are proper for the testimony of those witnesses. Respondent's position seeks efficiency: unlike Petitioner, who is refusing to produce witnesses for deposition on oral examination in the United States, Respondent fully intends to produce witnesses to testify about topics that are relevant at agreed-upon times and locations that are mutually convenient for the parties, after discussion among counsel. For these reasons, Petitioner's Further Motion to Compel should be denied.

## **II. Background Facts and Procedural Posture**

Pursuant to the Board's Order dated April 12, 2014, discovery was due to close on August 27, 2014. TTABVUE 24. On August 6, 2014 – more than twenty days before the close of the discovery period – Counsel for Respondent duly served deposition notices on Counsel for Petitioner for the deposition on oral examination of Lisa Turbis, Chris Young, Maurice Patel and Autodesk, Inc. (pursuant to Fed. R. Civ. P. 30(b)(6)). See TTABVUE 32 at Exhibit C. However, the next day, on August 7, 2014, after a request from Respondent for a meet and confer to discuss deficiencies in Petitioner's document production and discovery responses, **Autodesk** prematurely filed a Motion to Compel, and shortly thereafter, on August 8, 2014, the Board issued an Order stating, in relevant part, that “[t]he parties should not file any paper which is not germane to the motion to compel.” TTABVUE 25, 26. In view of the Motion to Compel and subsequent Suspension Order, which prevented Respondent from filing a Motion to Compel with respect to Autodesk's discovery deficiencies, Counsel for 3D Systems wrote to Counsel for Autodesk adjourning the noticed depositions *sine die* until such time as Autodesk's discovery

responses and document production were sufficiently complete.<sup>1</sup> See TTABVUE 32 at Exhibit D.

On October 30, 2014, the Board issued an Order summarily granting Petitioner's original Motion to Compel, and ordering Respondent to produce an enormous amount of information within 30 days, without any citation of legal authority or explanation of the basis for its decision. TTABVUE 29. Respondent, believing that the Board's decision was partially in error, served over 800 documents of responsive material (totaling more than 2,000 pages), along with supplemental discovery responses on Petitioner concerning those topics with which it did not take issue, and simultaneously filed a Motion for Reconsideration in Part ("Motion for Reconsideration") on November 29, 2014, seeking review of certain other aspects of the Board's Order. Exhibit 1, 2. TTABVUE 30. Respondent's Motion for Reconsideration is still being briefed.

Before Respondent was required to comply with the Board's Order, and without consulting Respondent about convenient times or locations, Petitioner served, by first-class mail, three notices of deposition which purported to notice depositions for Cathy Lewis, James Hopeck and 3D Systems (pursuant to Fed. R. Civ. P. 30(b)(6)), unilaterally selecting arbitrary dates in December for the depositions to take place in South Carolina. Exhibit 3. At the time Petitioner mailed the notices of deposition, and for the two to three weeks following service, Respondent's Counsel, Mr. Sneed, was traveling to and from Arizona, California, Ohio and North Carolina taking and defending expert depositions in an unrelated trademark litigation matter. Further, Respondent was in the process of complying with the Board's order from October 30, 2014, burdening Respondent with the responsibility of producing a large amount of information in a

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<sup>1</sup> Contrary to Petitioner's assertions, Respondent adjourned its depositions noticed on August 6, 2014, only until such time as Petitioner's production and discovery responses are sufficiently complete. Exhibit 4. Respondent addresses these depositions in its Motion to Compel filed December 13, 2014. TTABVE 32.

short window of time, and preparing its Motion for Reconsideration. Not until the week of Thanksgiving, and only two weeks after Petitioner first served its notices on Respondent, did Counsel for Petitioner write Respondent's Counsel attaching the notices and following up, but again failing to inquire whether the times and locations requested were convenient and accurate. Exhibit 5.

On December 8, 2014, Counsel for Petitioner wrote to Counsel for Respondent outlining perceived deficiencies in 3D Systems' document production made on November 29, 2014 in compliance with the parts of the Board's Order of October 30, 2014 for which it was not requesting reconsideration. Exhibit 6. That same day, Counsel for Respondent, who was at that time on vacation, responded and suggested a meet and confer to discuss these perceived deficiencies, and counsel for the parties met by telephonic conference on December 10, 2014. Exhibit 6. During this meet and confer, Counsel for the parties discussed the timing and scheduling of the depositions, including Petitioner's position that it would not produce key witnesses for deposition on oral examination, whether in the U.S. or otherwise. Iacona Decl. ¶ 3. However, during the call, Counsel for Petitioner never raised the issue of the alleged technological issues associated with Respondent's document production nor did Counsel for Petitioner articulate any perceived substantive deficiencies with such production, including Respondent's decision to withhold production of some documents until the Board resolves the pending Motion for Reconsideration. Iacona Decl. ¶ 5.

### **III. Argument**

#### **A. Petitioner Has Not Satisfied Its Obligation to Make a Good Faith Effort to Resolve the Issues Prior to Filing a Second Motion to Compel**

Yet again, Petitioner has prematurely sought the intervention of the Board, before having satisfied its obligation under Fed. R. Civ. P. 37(a)(1) and 37 C.F.R. § 2.120(e)(1) to make a good faith effort to resolve the issues presented in the motion prior to filing, and its motion thus should be denied. *Hot Tamale Mama...and More, LLC v. SF Investments, Inc.*, 110 USPQ2d 1080 (TTAB 2014); *see also generally* TTABVUE 20. This time, Petitioner initially raised the alleged deficiencies in Respondent's document production by letter, yet failed to follow up in a discussion specifically scheduled to discuss outstanding discovery issues before filing the instant motion.

And indeed, had Petitioner actually discussed the issues presented by its instant motion with Counsel for Respondent prior to filing, such issues could easily have been addressed without resorting to motion practice. For example, Respondent would have explained the alleged technological issues with its second document production if Petitioner's Counsel simply asked, during the meet and confer on December 10, 2014, what may have caused truncated emails to be produced and attachments to be excluded from the production. Respondent would also have remedied any deficiencies caused by the alleged technological issues if given the chance, and in fact, Respondent is in the process of making an additional document production correcting any alleged technological issues present with its November 29, 2014 production. A simple discussion during the meet and confer could have resolved this issue without necessitating the intervention of the TTAB. As such, Petitioner has utterly failed to comply with the requirements of Fed. R. Civ. P. 37(a)(1) and 37 C.F.R. § 2.120(e)(1), and its motion to compel should be denied in its entirety.

B. Respondent has Complied with Those Parts of the Board's Order for Which it is Not Seeking Reconsideration

Respondent has produced, in compliance with the Board's October 30<sup>th</sup> Order, more than 800 documents totaling over 2,000 pages, that are relevant and responsive to those aspects of the discovery requests for which Respondent is not seeking reconsideration of the Board's Order. *See* TTABVUE 30, at p. 1, n.1. Exhibit 1. Petitioner's complaints that Respondent did not produce documents "until essentially the last possible moment" are misplaced – pursuant to the Board's Order, Respondent was not required to make any production earlier than November 29, 2014. As such, Petitioner's Motion requesting the Board to order Respondent to produce additional documents related to these outstanding categories of documents is untimely and unnecessary. Respondent has already served documents and supplemental discovery responses addressing elements of the Board's order not contested by Respondent's Motion for Reconsideration. Exhibits 1, 2. And Respondent will produce supplemental responses and/or make a third document production – if required – once the Board has issued its order on Respondent's Motion for Reconsideration.

C. Respondent is Willing to Make Witnesses Available for Deposition at Mutually Convenient Times and Locations

Importantly, Respondent's Counsel was willing to discuss alternative dates and locations for the depositions, and at no time did Counsel for Respondent refuse to make witnesses available, Petitioner's Motion to Compel should be denied as unnecessary.<sup>2</sup> Petitioner's argument that it "attempted to notice the depositions for a convenient time and place" is

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<sup>2</sup> Respondent also has not waived its objections as less than 30 days have lapsed (including the Thanksgiving holiday) between Petitioner serving by mail its notices of deposition and Respondent's Counsel requesting a meet and confer to discuss the timing and scheduling of the parties' depositions. At no time during the telephonic conference on December 10, 2014—two days prior to Petitioner filing the instant motion—did Petitioner's Counsel articulate its belief that Respondent has allegedly since waived its objections to Petitioner's noticed depositions. Iacona Decl. ¶ 3. In fact, Petitioner's Counsel abruptly ended the call when Counsel for Respondent mentioned the inability of Respondent's witnesses to appear on the noticed dates and attempted to discuss Petitioner's own improper objections to Respondent's depositions notices. Iacona Decl. ¶ 3. Respondent cannot be charged with discovery failures that Petitioner's Counsel chose not to raise when Petitioner's Counsel petulantly ended the Rule 37 conference.

specious. Petitioner never consulted Counsel for Respondent as to a convenient time and place, and when Counsel for Respondent attempted to have a conversation about scheduling the depositions in a way that made sense, particularly given the deposition notices for Petitioner's witnesses that had been outstanding since August, and the pending Motion for Reconsideration, Counsel for Petitioner merely reiterated its demands that witnesses be made available in South Carolina on December 15-17. Iacona Decl. ¶ 4.

While it is customary in litigation, both in Federal District Court and before the TTAB, to notice depositions as placeholders, and then discuss mutually convenient dates and locations for the depositions to actually take place, this was not Petitioner's approach. Instead, Petitioner unilaterally demanded that the depositions go forward on the dates that it had selected without consulting Counsel for Respondent, and in the location that it had chosen without determining whether it was mutually convenient or not, or even whether the designated witnesses worked or resided in that location.

And indeed, South Carolina is not a convenient location for at least one of the noticed deponents who is based out of 3D Systems' office in Southern California—a location that would appear to be more convenient for both Petitioner and its Counsel, who are both based in Northern California. Moreover, the December dates unilaterally selected by Counsel for Petitioner made no sense for depositions in view of the pending Motion for Reconsideration, which would, if granted, curtail areas of questioning about topics the relevance of which is in dispute. As such, the dates unilaterally selected by Counsel for Petitioner were neither convenient nor in the interest of efficiency. Petitioner's Counsel, however, firmly and repeatedly stated that despite Respondent's willingness to discuss the taking of depositions, Petitioner would seek court intervention. Iacona Decl. ¶ 4.



D. Conclusion

Petitioner's motion is both premature and unnecessary. For this reason, and the other foregoing reasons, Respondent respectfully requests that the Board deny Petitioner's Further Motion to Compel in its entirety. Given the challenges in dealing with seemingly fundamental discovery scheduling issues with Petitioner's Counsel, Respondent also would invite the Interlocutory Attorney's participation in any future meet-and-confer conferences.

Dated: January 2, 2015

Respectfully Submitted,

/s/ Jason Sneed

Jason M. Sneed, Esq.

Sarah C. Hsia, Esq.

Gina Iacona, Esq.

SNEED PLLC

610 Jetton St., Suite 120-107

Davidson, NC 28036

Tel.: 704-779-3611

Email: [JSneed@SneedLegal.com](mailto:JSneed@SneedLegal.com)

*Attorneys for Respondent 3D Systems, Inc.*

Certificate of Filing / Certificate of Service

The undersigned hereby certifies that the foregoing *Respondent's Opposition to Petitioner's Further Motion to Compel* was filed via ESTTA, and that a copy was placed in U.S. Mail, postage prepaid, addressed to the following counsel of record:

John L. Slafsky  
Wilson Sonsini Goodrich & Rosati  
650 Page Mill Road  
Palo Alto, California 94304-1050  
*Attorneys for Petitioner Autodesk, Inc.*

This the 2<sup>nd</sup> day of January, 2015.

/s/ Gina Iacona  
An Attorney for Respondent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Registrant: 3D Systems, Inc.  
Mark: 3DS & Design  
Reg. No.: 4,125,612 in Classes 1, 7, 9 and 40  
Registered: April 10, 2012

	)	
Autodesk, Inc.	)	
	)	
Petitioner,	)	
	)	
v.	)	Cancellation No. 92056509
	)	
3D Systems, Inc.,	)	
	)	
Respondent	)	

**DECLARATION OF GINA IACONA IN SUPPORT OF RESPONDENT'S FURTHER  
MOTION TO COMPEL DISCOVERY**

I, Gina Iacona, declare:

1. I am an associate at Sneed PLLC, counsel for Respondent 3D Systems ("3D Systems") in this matter. I have personal knowledge of the facts set forth in this declaration, and if called as a witness I could competently testify to them.

**Meet and Confer on December 10, 2014**

2. Attached hereto as Exhibit 6 is a true and correct copy of an e-mail exchange between the parties' counsel dated December 8-10, 2014, including Counsel for Respondent's request to schedule a meet and confer to discuss the parties' deposition notices and scheduling. See Exhibit 6.

3. On December 10, 2014, during the parties' telephonic meet and confer, Counsel for the parties discussed the timing and scheduling of the depositions, including Petitioner's position that it would not produce key witnesses for deposition on oral examination, whether in

the U.S. or otherwise, despite Counsel for Respondent's willingness to travel abroad to take depositions. In fact, Petitioner abruptly ended the meet and confer when Counsel for Respondent attempted to discuss Petitioner's own improper objections to Respondent's depositions notices.

4. Petitioner never consulted with Counsel for Respondent during the meet and confer as to a convenient time and place to take the noticed depositions. In fact, Petitioner's Counsel firmly and repeatedly stated that despite Respondent's willingness to discuss the taking of depositions, Petitioner would seek court intervention. Specifically, when Respondent's Counsel attempted to have a conversation about scheduling depositions in a way that made sense—particularly given the deposition notices for Petitioner's witnesses that had been outstanding since August and the pending Motion for Reconsideration—Counsel for Petitioner merely reiterated its demands that witnesses be made available in South Carolina on December 15-17. Petitioner's Counsel further never articulated during the meet and confer that Petitioner believed that Respondent had waived any objections to Petitioner's flawed deposition notices.

5. Still further during the meet and confer, Counsel for Petitioner never raised the issue of the alleged technological issues associated with Respondent's document production nor did Counsel for Petitioner articulate any perceived substantive deficiencies with such production, including Respondent's decision to withhold production of some documents until the Board resolves the pending Motion for Reconsideration.

I declare that the foregoing is true and correct to the best of my knowledge and recollection. Executed at Charleston, South Carolina, on January 2, 2015.

/s/ Gina Iacona  
Gina Iacona

# Exhibit 1

# 3D Systems' Supplemental Document Production

Gina Iacona

Sat 11/29/2014 11:25 PM

Sent Items

To: JSlafsky@wsgr.com <JSlafsky@wsgr.com>; sbrannen@wsgr.com <sbrannen@wsgr.com>;

Cc: Jason M. Sneed <jsneed@SneedLegal.com>; Sarah Hsia <Sarah@SneedLegal.com>;

3D Systems' supplemental document production is now available in the same database you used to view our initial production. You will need to go to <https://sneed-legal.trialmanager.com/case/11190002/> and sign in to the account you previously created to view all documents produced.

This production is to be treated with the confidentiality levels set forth on the materials per the Board's standard protective order, pending the finalization of any amendments to such order.

Sincerely,

**Gina R. Iacona, Esq.**

SNEED PLLC  
610 Jetton St., Suite 120-107  
Davidson, North Carolina 28036  
Physical Office: Sullivan's Island, SC  
Firm: 844-763-3347  
Direct: 561-239-0117  
Email: [Glacona@SneedLegal.com](mailto:Glacona@SneedLegal.com)  
[www.SneedLegal.com](http://www.SneedLegal.com)

*This communication, including attachments, may contain information that is confidential and proprietary, and may be protected by the attorney / client or other privileges. If the reader or recipient of this communication is not the intended recipient, an employee or agent of the intended recipient who is responsible for delivering it to the intended recipient, or you believe that you have received this communication in error, please notify Sneed PLLC immediately by email reply and promptly delete this email, including attachments without reading or saving them in any manner. The unauthorized use, dissemination, distribution, or reproduction of this email, including attachments, is prohibited and may be unlawful. Receipt by anyone other than the intended recipient(s) is not a waiver of any attorney / client or other privilege.*

## Exhibit 2

November 29, 2014

*via U.S. Mail*

John L. Slafsky, Esq.  
Wilson Sonsini Goodrich & Rosati LLP  
650 Page Mill Road  
Palo Alto, CA 94304-1050  
jslafsky@wsgr.com

Re: *Autodesk, Inc. v. 3D Systems, Inc.*, Trademark Trial and Appeal Board  
Cancellation No. 92056509

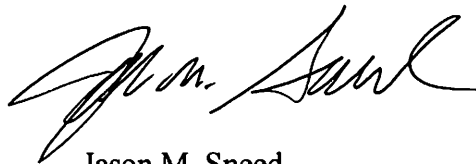
Dear John:

In our email sent today, we have provided you with 3D Systems' supplemental document production and a code to enable you to download it. Enclosed please also find the following:

- *Respondent's Supplemental Responses and Objections to Certain Interrogatories;*
- *Respondent's Supplemental Responses and Objections to Certain Requests for Production;*
- *Respondent's Supplemental Privilege Log.*

Please let us know if you have any questions.

Sincerely,



Jason M. Sneed

cc: Sarah C. Hsia, Esq., SNEED PLLC  
Gina R. Iacona, Esq., SNEED PLLC



# Exhibit 3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

AUTODESK, INC.,	)	
	)	
Petitioner,	)	Cancellation No. 92056509
	)	
v.	)	
	)	
3D SYSTEMS, INC.,	)	
	)	
Respondent.	)	

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**NOTICE OF DEPOSITION OF CATHY LEWIS**

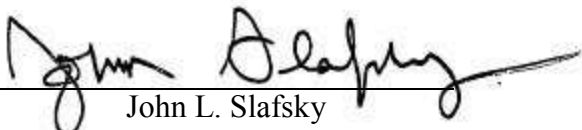
PLEASE TAKE NOTICE that, pursuant to Rule 30 of the Federal Rules of Civil Procedure and TBMP § 404.05, Petitioner Autodesk, Inc. ("Autodesk"), will take the deposition upon oral examination of Cathy Lewis, Chief Marketing Officer, 3D Systems, Inc. Ms. Lewis was identified in the Initial Disclosures of Respondent 3D Systems, Inc., in the above-captioned action.

The deposition will begin on December 16, 2014 at 10 a.m. at the Hilton Garden Inn Rock Hill, located at 650 Tinsley Way, Rock Hill, South Carolina 29730. The deposition will be transcribed stenographically, and will continue from day-to-day until completed. You are invited to attend and cross-examine.

Dated: November 10, 2014

Respectfully submitted,

WILSON SONSINI GOODRICH & ROSATI  
Professional Corporation

By:   
John L. Slafsky

Attorneys for Petitioner  
AUTODESK, INC.

**CERTIFICATE OF SERVICE BY MAIL**

I, Elvira Minjarez, declare:

I am employed in Santa Clara County. I am over the age of 18 years and not a party to the within action. My business address is Wilson Sonsini Goodrich & Rosati, 650 Page Mill Road, Palo Alto, California 94304-1050.

I am readily familiar with Wilson Sonsini Goodrich & Rosati's practice for collection and processing of correspondence for mailing with the United States Postal Service. In the ordinary course of business, correspondence would be deposited with the United States Postal Service on this date.

On this date, I served **NOTICE OF DEPOSITION OF CATHY LEWIS** on each person listed below, by placing the document described above in an envelope addressed as indicated below, which I sealed. I placed the envelope for collection and mailing with the United States Postal Service on this day, following ordinary business practices at Wilson Sonsini Goodrich & Rosati.

Jason M. Sneed  
Sneed PLLC  
610 Jetton St, Suite 120-107  
Davidson, NC 28036

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct. Executed at Palo Alto, California on November 10, 2014.

  
\_\_\_\_\_  
Elvira Minjarez

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

AUTODESK, INC.,	)	
	)	
Petitioner,	)	Cancellation No. 92056509
	)	
v.	)	
	)	
3D SYSTEMS, INC.,	)	
	)	
Respondent.	)	

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**NOTICE OF DEPOSITION OF JAMES HOPECK**

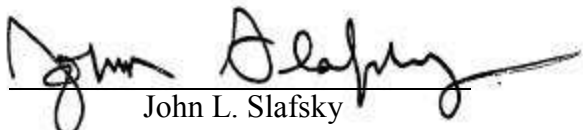
PLEASE TAKE NOTICE that, pursuant to Rule 30 of the Federal Rules of Civil Procedure and TBMP § 404.05, Petitioner Autodesk, Inc. ("Autodesk"), will take the deposition upon oral examination of James Hopeck, Vice-President and Corporate Controller, 3D Systems, Inc. Mr. Hopeck was identified in the Initial Disclosures of Respondent 3D Systems, Inc., in the above-captioned action.

The deposition will begin on December 15, 2014 at 10 a.m. at the Hilton Garden Inn Rock Hill, located at 650 Tinsley Way, Rock Hill, South Carolina 29730. The deposition will be transcribed stenographically, and will continue from day-to-day until completed. You are invited to attend and cross-examine.

Dated: November 10, 2014

Respectfully submitted,

WILSON SONSINI GOODRICH & ROSATI  
Professional Corporation

By:   
John L. Slafsky

Attorneys for Petitioner  
AUTODESK, INC.

**CERTIFICATE OF SERVICE BY MAIL**

I, Elvira Minjarez, declare:

I am employed in Santa Clara County. I am over the age of 18 years and not a party to the within action. My business address is Wilson Sonsini Goodrich & Rosati, 650 Page Mill Road, Palo Alto, California 94304-1050.

I am readily familiar with Wilson Sonsini Goodrich & Rosati's practice for collection and processing of correspondence for mailing with the United States Postal Service. In the ordinary course of business, correspondence would be deposited with the United States Postal Service on this date.

On this date, I served **NOTICE OF DEPOSITION OF JAMES HOPECK** on each person listed below, by placing the document described above in an envelope addressed as indicated below, which I sealed. I placed the envelope for collection and mailing with the United States Postal Service on this day, following ordinary business practices at Wilson Sonsini Goodrich & Rosati.

Jason M. Sneed  
Sneed PLLC  
610 Jetton St, Suite 120-107  
Davidson, NC 28036

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct. Executed at Palo Alto, California on November 10, 2014.

  
Elvira Minjarez

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

AUTODESK, INC.,	)	
	)	
Petitioner,	)	Cancellation No. 92056509
	)	
v.	)	
	)	
3D SYSTEMS, INC.,	)	
	)	
Respondent.	)	

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**NOTICE OF DEPOSITION**

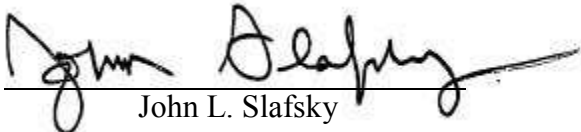
PLEASE TAKE NOTICE that, pursuant to Rule 30 of the Federal Rules of Civil Procedure and TBMP § 404.05, Petitioner Autodesk, Inc. ("Autodesk"), will take the deposition upon oral examination of Respondent 3D Systems, Inc. ("3D Systems"). Pursuant to Federal Rule of Civil Procedure 30(b)(6), 3D Systems shall designate "one or more officers, directors, or managing agents, or other persons who consent to testify on its behalf" to testify as to information known or reasonably available to 3D Systems regarding the subject matters set forth in Exhibit A hereto.

The deposition will begin on December 17, 2014 at 10 a.m. at the Hilton Garden Inn Rock Hill, located at 650 Tinsley Way, Rock Hill, South Carolina 29730. The deposition will be transcribed stenographically, and will continue from day-to-day until completed. You are invited to attend and cross-examine.

Dated: November 10, 2014

Respectfully submitted,

WILSON SONSINI GOODRICH & ROSATI  
Professional Corporation

By:   
John L. Slafsky

Attorneys for Petitioner  
AUTODESK, INC.

## **EXHIBIT A**

### **DEFINITIONS**

As used herein, the following terms have the following definitions:

- a. “3D Systems” means not only 3D Systems, but also its partners, agents, officers, employees, representatives, and attorneys, and any predecessors, subsidiaries, controlled and affiliated companies, and their agents, officers, employees, representatives and attorneys.
- b. “3DS & Design Mark” refers to the subject of U.S. Reg. No. 4,125,612.
- c. “3DS MAX Mark” refers to the subject of U.S. Reg. No. 2,733,869.

### **TOPICS**

- 1. The application to register the 3DS & Design Mark.
- 2. The identity of any competitors of 3D Systems.
- 3. The classes of purchasers to who 3D Systems markets, advertises or promotes its products and services.
- 4. Autodesk’s 3DS MAX mark and its 3DS MAX product.
- 5. 3D Systems’ past and present plans for use of the designation “3DS” or variations thereof in connection with its branding, advertising, marketing or promotion.
- 6. The adoption and use of the 3DS & Design Mark by 3D Systems.
- 7. 3D Systems’ awareness of Autodesk’s 3DS MAX Mark and 3DS MAX product.
- 8. The products and services offered by 3D Systems and by Autodesk, respectively.
- 9. Future products and services to be offered by 3D Systems and by Autodesk, respectively.
- 10. Consumer confusion, if any, between products developed or distributed by 3D Systems and products developed or distributed by Autodesk.
- 11. Consumer awareness of the 3DS & Design Mark.
- 12. 3D Systems’ efforts or plans, if any, to interest users of Autodesk products or services in 3D Systems products or services.
- 13. 3D Systems’ efforts to preserve, collect and produce documents and information responsive to Autodesk’s discovery requests.

**CERTIFICATE OF SERVICE BY MAIL**

I, Elvira Minjarez, declare:

I am employed in Santa Clara County. I am over the age of 18 years and not a party to the within action. My business address is Wilson Sonsini Goodrich & Rosati, 650 Page Mill Road, Palo Alto, California 94304-1050.

I am readily familiar with Wilson Sonsini Goodrich & Rosati's practice for collection and processing of correspondence for mailing with the United States Postal Service. In the ordinary course of business, correspondence would be deposited with the United States Postal Service on this date.

On this date, I served **NOTICE OF DEPOSITION** on each person listed below, by placing the document described above in an envelope addressed as indicated below, which I sealed. I placed the envelope for collection and mailing with the United States Postal Service on this day, following ordinary business practices at Wilson Sonsini Goodrich & Rosati.

Jason M. Sneed  
Sneed PLLC  
610 Jetton St, Suite 120-107  
Davidson, NC 28036

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct. Executed at Palo Alto, California on November 10, 2014.

  
Elvira Minjarez



# Exhibit 4

August 2, 2014

*via email*

John L. Slafsky, Esq.  
Wilson Sonsini Goodrich & Rosati LLP  
650 Page Mill Road  
Palo Alto, CA 94304-1050  
jslafsky@wsgr.com

Re: *Autodesk, Inc. v. 3D Systems, Inc.*, Trademark Trial and Appeal Board  
Cancellation No. 92056509

Dear John:

We were surprised – to say the least – to understand that you filed a Motion to Compel shortly after receiving our letter dated August 5, 2014 concerning the continuing deficiencies in Autodesk's discovery responses and document production and requesting a meet and confer to discuss the remaining deficiencies and to satisfy our obligation under Fed. R. Civ. P. 37(a)(1) and 37 C.F.R. § 2.120(e)(1) to make a good faith effort to resolve these issues prior to filing a Motion to Compel.

Your Motion to Compel comes without warning, after months of silence from you, and with no communication from you whatsoever subsequent to receipt of 3D Systems' document production outlining any continuing objections from you or your client as to the sufficiency of said production. We do not believe that you have complied with your obligation under Fed. R. Civ. P. 37(a)(1) and 37 C.F.R. § 2.120(e)(1) to make a good faith effort to resolve issues prior to filing a Motion to Compel, and we thus ask that you withdraw your motion to avoid unnecessary motion practice and the cost associated therewith.

We further note that your Motion to Compel was filed *after* service (including a courtesy copy by email) of 3D Systems' second set of discovery requests on August 6, 2014, and your client's obligation to timely respond thereto is thus not affected by the suspension order.

As for the depositions that we also noticed on August 6, 2014, in view of your Motion to Compel, and refusal to provide us with dates and times that you are available to meet and confer, we will be adjourning these depositions *sine die* until such time as Autodesk's production and discovery responses are sufficiently complete.

We also reiterate our request – made in our letter of August 5, 2014 – that you provide dates and times that you are available for a meet and confer to discuss the issues set forth therein.

Sincerely,

A handwritten signature in black ink, appearing to read "Sarah C. Hsia". The signature is fluid and cursive, with the first name "Sarah" being more prominent and the last name "Hsia" following in a similar style.

Sarah C. Hsia, Esq.

cc: Jason M. Sneed, Esq. (via email)  
Stephanie Brannen, Esq. (via email)

# Exhibit 5

November 24, 2014

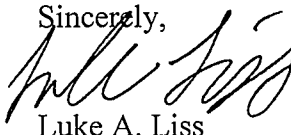
*Via Email*

Jason M. Sneed, Esq.  
Sarah C. Hsia, Esq.  
Sneed pllc  
610 Jetton St., Suite 120-107  
Davidson, NC 28036

Dear Jason and Sarah:

As you know, we served three deposition notices on you via mail on November 10, 2014 (copies are attached for your convenience). We have not received objections or otherwise heard from you regarding the depositions and, accordingly, we are proceeding with travel and other arrangements. We note that under the TBMP and Federal Rules of Civil Procedure, objections to deposition notices are waived when not promptly served in writing. *See* TBMP 404.08(a); Fed. R. Civ. P. 32(d)(1).

Sincerely,



Luke A. Liss

Enclosures

# Exhibit 6

# RE: Autodesk v. 3D Systems

Jason M. Sneed

Wed 12/10/2014 2:48 PM

Inbox

To: Liss, Luke <lliss@wsgr.com>; Sarah Hsia <Sarah@SneedLegal.com>;

Cc: Slafsky, John <JSlafsky@wsgr.com>; Brannen, Stephanie <sbrannen@wsgr.com>; Gina Iacona <GIacona@SneedLegal.com>;

Please call our conference line then:

888-861-1255

Participant PIN: 618136#.

Thank you.

*Jason*

**Jason M. Sneed, Esq.**

**SNEED PLLC**

610 Jetton St., Suite 120-107

Davidson, NC 28036

704-779-3611 (tel)

[JSneed@SneedLegal.com](mailto:JSneed@SneedLegal.com)

[www.SneedLegal.com](http://www.SneedLegal.com)

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**From:** Liss, Luke [<mailto:lliss@wsgr.com>]

**Sent:** Wednesday, December 10, 2014 2:08 PM

**To:** Jason M. Sneed; Sarah Hsia

**Cc:** Slafsky, John; Brannen, Stephanie

**Subject:** RE: Autodesk v. 3D Systems

We will call you at 3 pm ET today.

Thanks,

Luke

---

**From:** Jason M. Sneed [<mailto:jsneed@SneedLegal.com>]

**Sent:** Wednesday, December 10, 2014 11:01 AM

**To:** Liss, Luke; Sarah Hsia

**Cc:** Slafsky, John; Brannen, Stephanie

**Subject:** RE: Autodesk v. 3D Systems

Counsel,

I don't believe we received your confirmation of the time of today's call, but regardless, could we move it back to 3pm ET? If that is not available (your schedule below indicates it may not be), then could we push our call back to tomorrow? I would offer any time from 1-5 p.m. ET on Thursday.

Sincerely,

*Jason*

**Jason M. Sneed, Esq.**

**SNEED PLLC**

610 Jetton St., Suite 120-107

Davidson, NC 28036

704-779-3611 (tel)

[JSneed@SneedLegal.com](mailto:JSneed@SneedLegal.com)

[www.SneedLegal.com](http://www.SneedLegal.com)

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**From:** Liss, Luke [<mailto:lliss@wsgr.com>]

**Sent:** Monday, December 08, 2014 7:42 PM

**To:** Jason M. Sneed; Sarah Hsia

**Cc:** Slafsky, John; Brannen, Stephanie

**Subject:** RE: Autodesk v. 3D Systems

Jason:

We remain prepared to proceed with the depositions next week, as noticed. As you know, these depositions were noticed a month ago, on November 10, and we then followed up (i) to confirm the scheduling and (ii) note the absence of objections two weeks ago, on November 24. Your e-mail today is the first time that we have received any response to the deposition notices or to our follow-up communication.

You have not addressed our concerns below about the problems with the documents that you recently produced pursuant to Board order. So that we may prepare for the depositions, please address the document issues as soon as possible, preferably tomorrow.

As you know, we previously expressed concern to you, via letter dated August 11 and subsequent written objections served on August 22, about procedural deficiencies with respect to the notices of deposition that you served (and then adjourned). You indicated last summer that you intended to "take action" on this issue, but we have not heard further from you concerning this issue for well over three months now.

We are available to confer about the depositions either tomorrow at 2-2:30pm PT or on Wednesday 9-12 or 2-5 PT. Please let us know which time works best and whether we should call your office.

Luke



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**From:** Jason M. Sneed [<mailto:jsneed@SneedLegal.com>]  
**Sent:** Monday, December 08, 2014 11:10 AM  
**To:** Liss, Luke; Sarah Hsia  
**Cc:** Slafsky, John; Brannen, Stephanie  
**Subject:** Re: Autodesk v. 3D Systems

We need to discuss the parties' deposition notices and scheduling. I would propose a call for Wednesday. We have not confirmed those dates you selected.

Jason

SNEED PLLC  
Jason M. SNEED, Esq.  
610 Jetton St., Suite 120-107  
Davidson, NC 28036  
704-779-3611 (direct)  
[JSneed@SneedLegal.com](mailto:JSneed@SneedLegal.com)  
[www.SneedLegal.com](http://www.SneedLegal.com)

----- Reply message -----

From: "Liss, Luke" <[lliss@wsgr.com](mailto:lliss@wsgr.com)>  
To: "Sarah Hsia" <[Sarah@SneedLegal.com](mailto:Sarah@SneedLegal.com)>, "Jason M. Sneed" <[jsneed@SneedLegal.com](mailto:jsneed@SneedLegal.com)>  
Cc: "Slafsky, John" <[JSlafsky@wsgr.com](mailto:JSlafsky@wsgr.com)>, "Brannen, Stephanie" <[sbrannen@wsgr.com](mailto:sbrannen@wsgr.com)>  
Subject: Autodesk v. 3D Systems  
Date: Mon, Dec 8, 2014 1:45 PM

Jason/Sarah,

We write regarding 3D Systems' document production of November 29. In short, there are fundamental issues with the way the documents were produced that affect numerous documents. For example, in a number of emails logos are missing, which are necessary to understand the context of discussions. An example is attached. In a number of other emails, it is clear there is text missing from communications, whether altered or otherwise. An example of this is also attached. As you know, depositions begin next Monday December 15th – please advise today whether you will correct the production and re-send to us by this Wednesday December 10 so that we may have correct documents for use during questioning.

Thanks,  
Luke

This email and any attachments thereto may contain private, confidential, and privileged material for the sole use of the intended recipient. Any review, copying, or distribution of this email (or any attachments thereto) by others is strictly prohibited. If you are not the intended recipient, please contact the sender immediately and permanently delete the original and any copies of this email and any attachments thereto.